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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,358	09/26/2003	Boris E. Paton	7704.003DIV2	3805

7590 09/28/2006  
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EXAMINER	
ROLLINS, ROSILAND STACIE	
ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

88

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/673,358	PATON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rosiland S. Rollins	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-41 and 65-78 is/are pending in the application.
- 4a) Of the above claim(s) 69,70 and 75-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-41, 65-68, 71-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 39, 65, 67, 71 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmaltz et al. (US 6050996).**

In figure 1, Schmaltz et al. disclose an apparatus for bonding soft biological tissue having an incision therein, comprising: forceps (**10**) adapted to grip a portion of the tissue on both sides of the incision; electrodes (**11/12**) secured to the forceps for contacting the tissue portion; and an adjustable stop member (**31**) that limits the extent to which the forceps may be deformed, the stop member being adjustable to accommodate the bonding of tissues of varying thicknesses to provide tissue welding that forms a weld to reconnect the tissue.

**Regarding claim 65**, figure 1 of Schmaltz et al. illustrate the forceps having two arms, and the adjustable stop member being positioned between the two arms of the forceps.

**Regarding claims 67 and 73** the ridges illustrated in figure 1 of Schmaltz et al. are understood by the Examiner to be one or more spacers.

**Claims 39 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Buysse et al. (US 5776130).**

In figure 2, Buysse et al. disclose an apparatus for bonding soft biological tissue having an incision therein, comprising: forceps (**16**) adapted to grip a portion of the tissue on both sides of the incision; electrodes (**23**) secured to the forceps for contacting the tissue portion; and an adjustable stop member (**22**) that limits the extent to which the forceps may be deformed, the stop member being adjustable to accommodate the bonding of tissues of varying thicknesses to provide tissue welding that forms a weld to reconnect the tissue.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40, 41, 66 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al.

Schmaltz et al. teach all of the limitations of the claims except the electrodes being made of a metal with a high heat conductivity, the electrodes being dimensioned

Art Unit: 3739

to have a volume which is at least 5 times that of the tissue portion volume and the lug being replaceable.

**Regarding claim 40**, it would have also been obvious to the artisan at the time the invention was made to provide electrodes dimensioned to have a volume which is at least 5 times that of the tissue portion volume, since it has been held that discovering the optimum dimension involves only routine skill in the art.

**Regarding claim 41**, it would have been obvious to the artisan at the time the invention was made to provide electrodes made of a metal with a high heat conductivity, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

**Regarding claims 66 and 72**, Examiner takes official notice that the artisan would consider the stop member disclosed by Schmaltz et al. to be a lug. Schmaltz et al. fail to disclose the lug as being replaceable. It would have been obvious to the artisan to make the lug replaceable, since it has been held that the provision of an article being replaceable involves only routine skill in the art.

**Claims 68 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al. further in view of Choudhury (US 5219354).**

Schmaltz et al. teach all of the limitations of the claims except the adjustable stop member comprising an adjustable knob.

Choudhury disclose a forceps device that includes an adjustable stop member that comprises an adjustable knob **(51)**, which provides an automatic lock release

Art Unit: 3739

system for the forceps. Therefore, it would have been obvious to the artisan to provide an adjustable knob on the stop member of Schmaltz et al. as taught by Choudhury to lock the forceps in place once applied to the treatment area.

### ***Response to Arguments***

Applicant's arguments filed 7/10/06 have been fully considered but they are not persuasive.

In response to applicant's argument that Schmaltz and Buysse do not limit the extent to which pressure may be applied about the incision so as to prevent overexertion, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues that the structure and function of the disclosed one or more spacers is inherently different from, and therefore, not anticipated by the ridges illustrated in Figure 1 of the Schmaltz prior art. Applicant also states that, the one or more spacers of the current invention specifically stop the exertion of too much pressure and prevent excessive compression of tissue. Regarding this argument, Applicant has failed to identify any structural differences between the spacers claimed and the spacers identified in Schmaltz by the Examiner.

Applicant has respectfully disagreed with Examiner and re-asserted that, because such elements are not even contemplated by the cited prior art, claims 40 and 41 are not obvious. As stated in the rejection above, the limitations of claims 40 and 41

Art Unit: 3739

are obvious design choices. Applicant also states that the Schmaltz ratchets are inherently different, structurally and functionally from the current invention's disclosed lug but has failed to specifically point out those structural differences.

Applicant has vigorously argued that the knob as disclosed in Choudhury is completely different from the knob of the current invention. Applicant states that, merely because both the current specification and the prior art refer to a structure, as a "knob" does not mean that one renders the other obvious. In response to applicant's argument, it is noted that the features upon which applicant relies (i.e., the knob being stationary and on the external side of the arm) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 3739

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Rosiland S Rollins  
Primary Examiner  
Art Unit 3739